## Remarks

In the Office Action, the Examiner noted that claims 1 to 15 are subject to restriction. In particular, the Examiner has given a four-way restriction in accordance with 35 U.S.C. 121 as follows:

| *Inventions* | *Classification* |
|---|---|
| Group I. Claims 1-6, 14 and 15 drawn to a chemical compound and a pharmaceutical composition of formula I. | Not provided |
| Group II. Claim 7 drawn to a medicament comprising a chemical compound of formula I. | Not provided |
| Group III. Claim 8-13 drawn to a method of treatment of various disorders using a chemical compound of formula I. | Not provided |
| Group IV. Claim 8-13 drawn to a method of prophylaxis of various disorders using a chemical compound of formula I. | Not provided |

As indicated above, through this response, Applicants provisionally elect invention Group I ***with traverse***, namely, claims 1-6, 14 and 15 drawn to a chemical compound and a pharmaceutical composition of formula I. Additionally, as requested by the Examiner, Applicants have also provisionally elected with traverse a sub-generic species falling within the scope of invention Group I to be a compound of formula I, wherein $R_1 = R_3 = R_6 = R_7 = R_8$ = hydrogen, $R_2 = R_4$ = halogen, $R_5$ = alkyl, $R_9$ = L-G, wherein L = $NR_{30}CO$-, and G = $C_a(OR_{32})_xH_{2a+1-x}$, wherein $R_{30} = R_{32}$ = hydrogen and x = a = 5. A single specific compound falling within this sub-generic species is N-[3-(6,8-dichloro-2-methyl-1,2,3,4-tetrahydroisoquinolin-4-yl)phenyl]-(2R,3S,4R,5R)-2,3,4,5,6-pentahydroxyhexanamide, which is described as Example 2 at line 42, page 43 to line 22, page 44 of the specification. Please note that all of claims 1 to 6, 14 and 15 read on this elected subgeneric species as well as the single disclosed compound as provisionally elected herein. Examiner's imposition of five-way restriction is respectfully traversed below.

Applicants respectfully submit that this four-way restriction as imposed by the Examiner is improper based on the following grounds:

1. There is no undue burden on the Examiner to search for all of the claims as they are believed to be in same or similar classifications.

2. Product, process of making them and their uses should be rejoined pursuant to MPEP 821.04

Now, we address each one of these issues in greater detail. First, Applicants respectfully submit that the search of all of the claims 1 to 15 should not impose any undue burden on the Examiner. In support of our assertion, we draw Examiner's attention to the Table shown above, which lists all groupings of the invention. However, the Examiner has neither provided the search classifications for these invention groups nor she has provided reasoning for any undue burden on the Examiner to search these inventions together. Applicants respectfully submit that such assertions must be provided in the Office Action in support of any imposition of restriction requirement under 35 U.S.C. 121. Nevertheless it is respectfully submitted that all of the four invention groups are believed to be in the same or similar classifications. Thus it is submitted that all invention Groups can be searched together imposing no undue burden on the Examiner. Even more importantly, it should be noted that invention Group I is directed to compounds of formula I, and its pharmaceutical compositions. Whereas, invention Group II is directed to a medicament comprising a compound of Formula I. Further, invention Groups III and IV are directed to either method of treatment or prophylaxis of various disorders using a compound of formula I. Thus it is submitted that when the Examiner is searching for invention Group I, that itself may facilitate the search of invention Groups II to IV. Thus, it should not impose any undue burden on the Examiner to search all inventions together. Therefore, Applicants respectfully submit that all inventions be rejoined and examined together.

Secondly, Applicants submit that product and the related process and use claims should be rejoined pursuant to MPEP 821.04. As noted in MPEP 821.04:

> "However, if *applicant elects claims directed to the product*, and a product claim is subsequently found allowable, *withdrawn process claims* which depend from or otherwise include all the limitations of the allowable product claim *will be rejoined.*

> Where the application as originally filed discloses the product and the *process for making and/or using the product*, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the *process of making and/or using the patentable product by way of amendment pursuant* to **37 CFR 1.121**. (emphasis added)

As already discussed above, invention Group I, claims 1-6, 14 and 15, recites a compound of formula (I), and a pharmaceutical composition thereof. Whereas invention Group II, claim 7, is directed to a medicament comprising compound of formula I. In addition, invention Groups III and IV, claims 8-13, are directed to method of using a compound of formula I of invention Group I in treating or prophylaxis of various disorders. It should especially be noted that claims 7-13 depend directly or indirectly on claim 1 and incorporate all of the limitations of claim 1, i.e., of invention Group I. Thus, it is submitted that all invention Groups II to IV should be rejoined with invention Group I pursuant to provisions set out in MPEP 821.04, as also noted by the Examiner in the outstanding Office Action and in further accordance with the new guidelines established by the Office.

In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

Applicants believe there are no fees due for this response. However, if the Examiner deems that fees are due, please charge these fees to Deposit Account No. **18-1982** for sanofi-aventis, U.S. LLC, Bridgewater, NJ. Please credit any overpayment to Deposit Account No. **18-1982**.

Respectfully submitted,

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